

REMARKS

Introduction

This Amendment is submitted in response to an Office Action dated December 9, 2003. Claims 1-10 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Additionally, Claims 1, 6, 7 and 10 were rejected under 35 U.S.C. § 102(e). Further, Claims 1-10 were rejected under 35 U.S.C. § 103(a).

By this Amendment, Applicants have cancelled Claims 1-10 and added new Claims 21-77. Claims 21-77 are presently pending in this application, of which Claims 21, 40, 56, and 66 are in independent form. Applicants respectfully submit that all of the claims presently in the application find proper support in the specification and are in condition for allowance.

Rejection of Claims 1-10 under 35 U.S.C. § 112, second paragraph

Claim 1-10 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention. In particular, the Office Action asserts that Claim 1 is indefinite because “a data storage device” is recited three times and it is not clear whether one device is claimed three times or three different devices are claimed. Additionally, the Office Action asserts that Claim 1 is indefinite because “a user” and “user-selected” were recited, but it is not clear whether these two recitations necessarily deal with the same user.

Applicants have cancelled independent Claim 1, along with Claims 2-10 which depend from Claim 1. Applicants have carefully considered this rejection in the Office Action and

respectfully submit that the newly-added claims presently pending in the application clearly define what the Applicants regard as their inventions and conform to the requirements of Section 112, second paragraph. Support for the newly-added claims in this Amendment may be found in the specification, and it is respectfully submitted that no new matter has been added.

Therefore, Applicants believe that the rejection under Section 112, second paragraph, has been obviated, and its withdrawal is respectfully requested.

Rejection of claims as being unpatentable over *Haseltine*

Claims 1, 6, 7 and 10 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,578,015 to Haseltine et al. ("*Haseltine*"). Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Haseltine*. Applicants have cancelled Claims 1-10 in this Amendment, but respectfully traverse this rejection and hereby add new Claims 21-77.

The Office Action cites *Haseltine* as showing "all elements of the claims including servers in communication with each other, the servers comprising general data software (such as an operating system); data storage device; special purpose software comprising billing software; and a database; wherein the special purpose software receives data from a user via the internet (see e.g., Figs 3 and 4); stores the received data as internal data; and creates external data (comprising for instance an invoice and billing statement) from the internal data based upon user selected criteria (such as look and feel of billing)." The Office Action admits that *Haseltine* does not show distributing the server functions over a plurality of physical computers, but states that "[i]t would have been obvious to one of ordinary skill in the art to

modify the apparatus of Haseltine et al by distributing the servers over a plurality of computers.”

Haseltine, as understood by Applicants, describes methods and systems of presenting an electronic bill from a biller to a customer over a computer network. The Office Action states that *Haseltine* recites creating external data from internal data based upon user selected criteria. However, Applicants submit that *Haseltine* merely describes selecting and applying a format in which to present billing information to customers, such as by changing the “look-and-feel” of billing information to be provided in an invoice or billing statement. (Col. 5, lines 14-17 and col. 8, lines 50-57). *Haseltine* describes storing inputted bill data and bill format data, validating the inputted bill data, and then presenting the bill to the customer according to the format data. Col. 3, lines 8-17). *Haseltine* states “[t]he bill format data may include a plurality of bill templates, each of the bill templates defining a distinct appearance for the bill. A plurality of bill template rules may be evaluated based upon the validated bill data and one of the plurality of the bill templates may be selected to format the bill presented to the customer.” Col. 3, lines 21-27. (Emphasis added). The rules applied to the billing data in *Haseltine* relate only to formatting and presenting the unconverted billing data or determining which customer bills should be automatically paid. Col. 3, lines 21-36 and Col. 6, lines 27-50. The validating step referred to in *Haseltine* relates to insuring the integrity of the bill data, such as by verification of the customer’s identity. Col. 5, lines 39-49.

Applicants respectfully submit that nothing in *Haseltine* would teach or suggest to “retrieve a conversion parameter stored for the customer based upon a predetermined parameter specific to the customer [and] generate second data by converting the first data based on the

retrieved conversion parameter”, as in exemplary Claim 21 of the inventions as presently claimed. The inventions as presently claimed do not merely receive data and then format or change the appearance of the data on a bill to be provided to a customer, as in *Haseltine*. The inventions as presently claimed receive first data and convert it to generate second data from the first data, to be provided to a customer, based on stored conversion parameters that are specific to that customer. For example, the inventions as presently claimed may convert first data to generate second data by applying certain stored and/or selected customer specific parameters to perform calculations, conversions, or adjustments on the first data itself. Accordingly, Applicants respectfully submit that Claim 21 is not anticipated by *Haseltine*, nor obvious over *Haseltine*, since *Haseltine* contains no teaching or suggestion of converting first data to generate second data as presently claimed, nor is there any recognition in *Haseltine* that first data should be altered for any purpose. *Haseltine* teaches formatting changes made in presenting unaltered data, not changes to the actual data itself. Therefore, Applicants respectfully request withdrawal of these rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a).

Claims 22-39 depend from Claim 21. Accordingly, Applicants respectfully submit that claims 22-39 are allowable over *Haseltine* for at least the same reasons as discussed above in connection with Claim 21. Newly-added Claims 40, 56, and 66 are system and method claims that recite features that are similar in many respects to those of Claim 21. Accordingly, Applicants respectfully submit that Claims 41-55, which depend from Claim 40, Claims 57-65, which depend from Claim 56, and Claims 67-77 which depend from Claim 66 are allowable over *Haseltine* for at least the same reasons as discussed above in connection with Claim 21.

Rejection of claims as being unpatentable over Tran, Martin, and Fanjoy

Claims 1-3 and 6-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,991,742 to Tran ("*Tran*") in view of U.S. Patent No. 6,509,913 to Martin, Jr. et al. ("*Martin*"). Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tran* in view of *Martin*, and further in view of U.S. Patent No. 5,842,181 to Fanjoy et al. ("*Fanjoy*"). Applicants have cancelled Claims 1-10 in this Amendment, but respectfully traverse these rejections with respect to newly-added Claims 21-77 and submit the following arguments in support thereof.

The Office Action cites *Tran* as showing "servers in communication with each other, the servers comprising general data software (such as an operating system); data storage device; special purpose software comprising accounting, invoicing and billing software; and a database; wherein the special purpose software receives data from a user; stores the received data as internal data; and creates external data from the internal data based upon user selected criteria."

Tran, as understood by Applicants, describes systems and devices for recording time and expense data pertaining to performance of a task by a user, the task having a start time and a completion time. In *Tran*, as described in Figures 6 and 7, a user first enters information to a time slip regarding a particular task (Client ID, Matter ID, Activity ID). A clock is then started to cumulate the time spent working on the task. If the user stops the clock, the cumulated time spent working on the task is stored. The billing rate is retrieved from a file, based upon the

information entered for the task, and multiplied by the time cumulated time to arrive at the bill to the client. Col 12, line 36 – Col. 14, line 14.

However, Applicants respectfully submit that *Tran* does not teach or suggest to “retrieve a conversion parameter stored for the customer based upon a predetermined parameter specific to the customer, generate second data by converting the first data based on the retrieved conversion parameter, and store the first data, the second data, and the conversion parameter related to the customer”, as in exemplary Claim 21 of the inventions as presently claimed. The time entry routine in *Tran* describes retrieving a stored billing rate for a customer, based on descriptive codes entered by the user, and then multiplying the time taken to complete the task to obtain the bill for the client. Col. 12, line 36 – Col. 14, line 14. Although such stored billing rates may be particular to a customer, *Tran* does not teach or suggest retrieving a conversion parameter that has been stored for a particular customer to determine how to convert the data received for that particular customer, as in the inventions as presently claimed. *Tran* does describe certain general or default adjustments for the system that can be made to data entered in the time and expense entry routines, such as rounding the time period according to the user’s billing policy (Col. 13, line 66 – Col. 14, line 2), exchange rate conversion (Col. 15, lines 59 – 62), and allowing the user to determine or override certain expenses (Col. 15, line 64 – Col. 16, line 4). However, *Tran* does not teach or suggest a particular conversion parameter that has been predetermined and stored for a specific customer and that can be retrieved and applied to convert first data received for the customer in order to generate second data, as in the inventions as presently claimed. Further, *Tran* does not teach or suggest storing the first data received prior to conversion, the second data generated following

conversion, and the conversion parameter for the particular customer, as in the inventions as presently claimed.

Additionally, the Office Action fails to set forth adequate evidence as to why the proposed combination of *Tran* in view of *Martin*, or *Tran* in view of *Martin* and further in view of *Fanjoy*, should be made. As both the Board and the Federal Circuit have continuously reaffirmed,

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986) (citing *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). “[T]he factual inquiry whether to combine references must be thorough and searching.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). This factual question cannot “be resolved on subjective belief and unknown authority,” *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002); “it must be based on objective evidence of record.” *Id.* at 1343, 61 USPQ2d at 1434.

Ex parte Metcalf, 67 USPQ2d 1633, 1635 (B.P.A.I. 2003). See also In re Zurko, 258 F.3d 1379, 1383-86. As set forth in the above quotation and with reference to the cases cited therein, in order for a proper obviousness determination to be made, the Examiner must set forth explicitly where the motivation exists to combine the references that the Examiner contends would, when combined, yield all of the elements as claimed in the rejected claims. It is respectfully submitted that the Examiner has provided no motivation for making the proposed combination of *Tran* in view of *Martin*, nor *Tran* in view of *Martin*, and further in view of *Fanjoy*, and thus the combination is improper both for the reasons that there is no motivation, and additionally for the reason that even were the combination to be made the claimed invention would not

result. For example, the Federal Circuit, in In re Lee, stated that “when patentability turns on the question of obviousness, the search for an analysis of the prior art includes evidence relevant to the finding of whether there is a teaching motivation or suggestion to select and combine the references relied on as evidence of obviousness.” In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). The Court went on to state that “the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” Id. (internal citations omitted).

The Examiner is relying on *Martin* as showing the “transferring of data over the internet” and the Examiner states that “[i]t would have been obvious to one of ordinary skill in the art to modify the apparatus of Tran by providing an internet connection between the portable computing device and the servers in order to allow time and expense data to be submitted while away from the office.” The Examiner is relying on *Fanjoy* as showing “off-line software downloaded from the accounting servers” and the Examiner states that “[i]t would have been obvious to one of ordinary skill in the art to further modify the apparatus of Tran by providing downloadable software from the servers in order to ease updating of software when a new revision is provided.” Applicants respectfully submit that Examiner is citing to *Martin* and *Fanjoy* as showing the manner in which data can be transmitted over a network. However, Examiner does not submit, nor do *Martin* or *Fanjoy* provide any motivation, teaching, or suggestion to be combined with *Tran* to provide the inventions as previously or as presently claimed wherein a particular conversion parameter that has been predetermined and stored for a specific customer can be retrieved and applied to convert first data received for the customer in

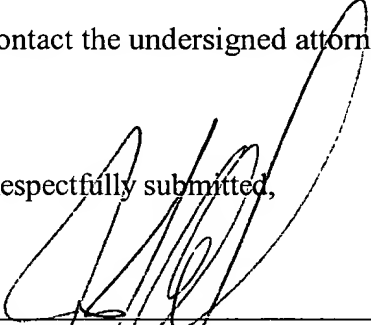
order to generate second data. Further, neither reference provides any motivation, teaching or suggestion of storing the first data received prior to conversion, the second data generated following conversion, and the conversion parameter for the particular customer, as in the inventions as presently claimed.

Applicants submit that even if the combination of references proposed by the Office Action were proper (a fact not conceded by Applicants), the combination would not yield the claimed inventions of the newly-added claims, for the reasons stated above. A review of the other art of record has not revealed anything which, in Applicants' opinion, would remedy the deficiencies of *Tran*, as a reference against the newly-added claims. Accordingly, Applicants respectfully submit that newly-added Claims 21-77 are not unpatentable over *Tran*, in view of *Martin*, nor further in view of *Fanjoy*, and respectfully request withdrawal of these rejections under 35 U.S.C. § 103(a).

CONCLUSION

Applicants have made a diligent effort to place the application in condition for allowance and respectfully submit that the claims as now presented are in condition for immediate allowance. If, however, the Examiner feels he cannot issue an immediate Notice of Allowance, the Examiner is respectfully requested to contact the undersigned attorney to discuss the outstanding issues.

Respectfully submitted,



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